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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,126	12/26/2001	Mark Lelental	83727D-W	3342

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EXAMINER

VUAYAKUMAR, KALLAMBELLA M

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,126

Applicant(s)

LELENTAL ET AL.

Examiner

Kallambella Vijayakumar

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

- Acknowledge the amending the specification, amending the claim-1 and canceling claims 13-16 with the response filed 07/28/2004. Claims 1-12 and 17-19 are currently pending with the application.
- Applicant's arguments, filed 07/28/2004, with respect to Claims 1-19 have been fully considered and are persuasive. The rejection of Claims under 35 USC 102/103 over Wessling (WO 99/05687), Cloots et al (EP 003179) and Muys et al (US Patent 5,391,472) and rejection under 103(a) over Cloots in view of Gardner et al have been withdrawn. Also the objection over Claim-6 and the specification have been withdrawn. However the arguments by the applicants are not persuasive over rejection under 35 USC 103(a) over Muys et al in view of Gardner et al, and this rejection is maintained for the following reasons:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 1-12 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muys et al (US Patent 5,391,472) as applied to claim 1 above, and further in view of Gardner et al (US Patent 5,910,385).

Muys et al disclose transparent-antistatic coating compositions comprising:

(i) *Poythiophene/polyanion dispersion* with a particle size of *5nm-1 micron*, wherein polyanion compound being polyacrylic acid or *polystyrene sulfonic acid* (Col-3, Ln-60 to Col-4, Ln: 24; Col5, Ln 16-65; Col-10, Ln: 8-54; Col-12, Table-1) < Limitation of Instant Claims: 1-2, 4-5, 10, 17-19>,

(ii) Various solvents/additives such as phenolic compounds, aliphatic polyhydroxy compounds such as *glycerol and sorbitol* < Limitation of Instant Claims: 1, 3, 6, 7, 9, and 11>, monomeric carboxylic acids such as *furancarboxylic acid and NMP* < Limitation of Instant Claims: 1, 3, 6, 7, 8, and 11-12> (Col-7, Lines: 25-53, Col-12, Table-1). The coating compositions given in Table-1 (Col-12) would meet the ratio limitations in instant claims 2-3. NMP, glycerol, sorbitol and polysaccharides would meet the limitation of neutral-charge conductivity enhancers in the instant claim-1.

(iii) A latex polymer binder having hydrophilic functionality such as copolymer of vinylidene fluoride and unsaturated carboxylic acid (Col-6, Lines: 55-60; Col-7, lines: 6-10, Col-9, Lines: 5-14, Col-12, Table-1).

Muys et al do not disclose or suggestive of the use of *gelatin or its derivatives* as the binder in the composition for forming electrically conductive antistatic layer, however the disclosure teaches all the other limitations of the instant claims by the applicants.

In the analogous art, Gardner et al teach making electrically conductive compositions comprising dispersion of polyaniline-protonic counter-ion complex with an electrical conductivity of 1×10^4 ohm-cm in a first solvent such as DMSO, NMP and various alcohol blends; and a second solvent such as chlorinated solvents, alcohols and glycol ethers; and a binder such as *gelatin* and cellulose esters (Abstract, Col-2, Lines: 52-63; Col-12, lines: 5-8; Col-14, Lines: 42-55; Col-15, Lines: 10-59).

It would have been obvious to one with ordinary skill in the art to modify the antistatic layer coating composition of Muys et al by optionally choosing gelatin as the binder per the teachings of Gardner et al to benefit from improved adhesion and antistatic characteristics, because Muys et al teaches all the elements of the antistatic composition except the use of gelatin binder, while Gardner et al teach the formulation of antistatic coating compositions comprising gelatin as binder and its benefits, and because both the disclosures are in the analogous art, and with the expectation of reasonable success in obviously arriving at the limitations of the instant claims by the applicants.

The office agrees with the applicants on the differences cited between the disclosures by Muys et al and Gardner et al, but respectfully disagrees with the "hindsight" reasoning for their combination. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so


long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

- The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Majumdar et al (US 6,077,655; Particularly Abstract and Col-7, Lines: 25-65) and Fuji Photo (JP 02-140139; Abstract).
- Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on M-Th, 07.00 - 16.30 hrs, Alt. Fri: 07.00-15.30 hrs.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMV
October 07, 2004


Mark Kopec
Primary Examiner